

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer No. 26817
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Serial No. 09/741,521	:	
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BRIEF ON APPEAL

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I. REAL PARTY IN INTEREST

The real party in interest of the above-captioned Application is the assignee, AEP Industries, Inc.

II. RELATED APPEALS AND INTERFERENCES

There is one appeal related to the instant Appeal. United States Patent Application Serial No. 09/970,015, filed October 3, 2001, entitled Film Cutter Assembly, is a continuation-in-part of the instant Application. A Notice of Appeal in Serial No. 09/970,015, appealing the Examiner's Office Action mailed January 21, 2010, was filed on February 18, 2010, and the Appeal Brief is being filed on even date herewith. No appeal number has been assigned yet. Except for the Appeal in Serial No. 09/970,015, there are no other appeals, interferences, or judicial proceedings known to appellants that will have a bearing on the Board's decision in the present Appeal.

III. STATUS OF CLAIMS

Claims 1-18 were filed with the original Application. Claims 20 and 21 were added during prosecution.

Claims 3, 4, 5, 6, 7, 11, 20 and 21 have been canceled. Claims 1, 2, 8, 9, 10, 12, 13, 14, 15, 16, 17, 18 and 19 remain pending in this Application. All of the remaining claims stand rejected and are the subject of this Appeal. No claims in the Application have been allowed. The Claims are reproduced in the CLAIMS APPENDIX.

IV. STATUS OF AMENDMENTS

The Amendment mailed September 24, 2004 in response to the Final Office Action mailed May 18, 2004 was not entered as set forth in the Advisory Action mailed October 25, 2004. The Amendment mailed March 30, 2007 in response to the Final Office Action mailed November 30, 2006 was not entered as set forth in the Advisory Action mailed May 1, 2007.

No amendments were filed subsequent to final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Appellants' claimed invention, as set forth in independent claim 1, is directed to a plastic film cutter apparatus with a housing/blade assembly that cuts film as it slides in a channel or cavity formed between two rails formed with a rail base (specification, page 2, line 31 to page 3, line 12, page 4, lines 15-22 and 32-35, Figure 1, nos. 10, 12, 14 - 19 and Figure 2, nos. 14, 15, 18-25). The blade housing assembly has an upper portion, a middle portion, and a lower portion. (specification, page 2, line 31 - page 3, line 7, page 4, lines 32-35, Figure 2, nos. 18-22). The upper portion houses a blade and has a bottom edge which protrudes on either end from the blade, and has an end surface that is rounded and inclined upwardly from either end of the bottom edge; the blade is angled from the bottom edge. (specification page 5, lines 5-12, Figure 3, nos. 19, 22-25). The lower portion of the housing forms a tracking device that slides in the channel. (specification page 5, lines 22-28, Figure 3, nos. 15, 18, 20, 29). The rail base is formed of a material having durability properties such as rigid vinyl or polyvinyl chloride ("PVC"), and the rails are formed of another material that is made of polyvinyl chloride comprising at least 10% of a plasticizer that provides a cling attraction to the film placed over the rails before, during and after the cutting of the film by the sliding of the blade housing within the channel. (specification page 5, lines 23 - 31). In addition, the rail base and rail materials can be coextruded to form the rail base/rail structure. (specification page 4, lines 23-31, Figure 1, nos. 12, 14).

In one embodiment of the claimed invention, as is set forth in dependent claim 2, which depends from claim 1, comprises the plastic film cutter of independent claim 1 wherein the

upper portion of the blade housing has a grip surface with a concave shape. (specification page 5, lines 17-21, Figure 3, nos. 18, 19 and 26).

In another embodiment of the claimed invention, as is set forth in dependent claim 8, which depends from claim 1, comprises the plastic film cutter of independent claim 1 wherein the blade housing is made of a flexible material that provides lubricity for sliding the housing along the top surface of the rails and within the cavity (specification page 5, lines 13-16).

A further embodiment of the claimed invention, as is set forth in dependent claim 9, which depends from claim 8, comprises the plastic film cutter of independent claim 1 wherein the flexible material of the blade housing is made of acetal or silicon (specification page 5, lines 13-16).

In still another embodiment of the claimed invention, as is set forth in dependent claim 10, which depends from claim 1, comprises the plastic film cutter of claim 1 wherein the housing has a left section and a right section, and the blade is attached to the left and right sections with a rivet to secure the blade in the housing to ensure safety (specification page 5, lines 29-33, Figure 5, nos. 22, and 31-34).

In another embodiment of the claimed invention, as is set forth in dependent claim 12, which depends from claim 1, the blade of the film cutter is angled at 30 degrees from the bottom edge of the upper portion of the housing (specification page 5, line 34 – page 6, line 10, Figure 6, nos. 22 and 36-39).

A further embodiment of the claimed invention, as is set forth in dependent claim 13, which is dependent from claim 1, the lower portion of the housing in the film cutter is formed

of a tracking device for sliding in the channel formed between the rails of the film cutter's rail base (specification page 5, lines 22-23, Figure 3, nos. 15, 20 and 29).

In still another embodiment of the claimed invention, as is set forth in claim 14, which depends from claim 13, the tracking device of the lower portion of the housing in the film cutter is formed of a tubular base, a middle portion that attaches the lower housing portion to the upper portion, and the tubular base slides in a channel that has a corresponding tubular shape (specification page 5, lines 22-28, Figure 3, nos. 15, 18 – 24, 29, Figure 5, nos. 15, 29).

In another embodiment of the claimed invention, as is set forth in claim 15, which depends from claim 14, the middle portion of the film cutter's housing has a predetermined length that provides clearance between the blade and the rails (specification page 5, lines 25-28, Figure 2, nos. 14, 18, 21, Figure 3, nos. 18, 21, 22, 29 and d2).

In yet another embodiment of the claimed invention, as is set forth in claim 16, which depends from claim 13, the film cutter's rail base has a pair of end caps that are releasably attached to either end of the elongated rail base so as to provide a bumper for the film cutter's tracking device (specification page 3, lines 13 – 15, page 6, lines 11-20, Figure 1, nos. 12, 50, Figure 5, nos. 50, 52 and 55).

In another embodiment of the claimed invention, as is set forth in claim 17, which depends from claim 16, the end caps of the film cutter's rail base include a pair of male protrusions that engage a pair of respective female receptacles on a slide surface of the rail base (specification page 6, lines 11-13, Figure 5, nos. 52 and 55).

In still another embodiment of the claimed invention, as is set forth in claim 18, which depends from claim 1, a rear edge of the film cutter's rail base has a depression that is adapted

to receive a cover of a carton that contains the film to be cut (specification page 3, lines 15 – 18, page 6, lines 21-25, Figure 5, nos. 62, 64, 65, Figure 6 nos. 60, 62, 63).

Another embodiment of the claimed invention, as is set forth in independent claim 19, is directed to a method of cutting plastic wrap that utilizes a film cutter apparatus having an elongated rail base with at least one rail formed at its top surface and receiving the plastic wrap over a pair of rails formed at a top surface of an elongated rail base (specification page 2, line 31 – page 3, line 12, page 4, lines 15 – 22, Figure 1, nos. 10, 12, 14, 16, 17, Figure 2, no. 14, Figure 4, no. 14). In addition, the method of this embodiment provides for clinging the plastic wrap to the rails; which rails are formed of a material that provides an attraction to the wrap for clinging the wrap to the rails. (specification page 4, lines 23-31). In addition, the material is selected from the group consisting of vinyl and polyvinyl chloride; and the polyvinyl chloride comprises at least 10 percent plasticizer (specification page 4, lines 24-30). The rail base is formed of a material of rigid vinyl or rigid PVC. (specification page 4, lines 23 – 25.) The rail base materials and the rail materials are coextruded (specification page 4, lines 30-31). The method further provides for cutting the plastic wrap with a blade that is housed in a blade housing, and the blade is angled from the bottom edge of an upper portion of the housing, and the housing slides in a channel formed within the rail base between the rails (specification page 4, lines 15 – 22, page 4, line 32 – page 5, line 12, page 5, lines 22 – 23, page 5, line 34 – page 6, line 10, Figure 1, nos. 12, 15, 16, 18, 19, Figure 2, nos. 14, 15, 18-25, Figure 3, nos. 15, 18, 19, 22 – 24, Figure 4, nos. 14, 15, 18, Figure 6, nos. 20, 22 and 36-39). Finally, the claimed method provides that the plastic wrap clings to the rails before, during and after the cutting of the plastic wrap (specification page 4, lines 25 - 27).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 8-10, 12-15, 18 and 19 are obvious under 35 U.S.C. § 103(a) over U.S. Patent 5,440,961 to Lucas ("**Lucas**", Evidence Appendix, Ex. 1), in view of U.S. Patent 3,549,066 to Wankow ("**Wankow**", Evidence Appendix, Ex. 2) with supporting evidence from U.S. Patent 5,524,515 to Boda ("**Boda**", Evidence Appendix, Ex. 3), U.S. Patent 4,210,043 to Urion ("**Urion**", Evidence Appendix, Ex. 4) and U.S. Patent 5,036,740 to Tsai ("**Tsai**", Evidence Appendix, Ex. 5).

Whether claim 2 is obvious under 35 U.S.C. § 103(a) over **Lucas** in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, **Tsai**, and further in view of U.S. Patent 4,960, 022 to Chuang ("**Chuang**", Evidence Appendix, Ex. 6).

Whether claims 16 and 17 are obvious under 35 U.S.C. § 103(a) over **Lucas** in view of **Wankow** with supporting evidence from **Boda**, **Urion**, **Tsai** and further in view of U.S. Patent 5,398,576 to Chiu ("**Chiu**", Evidence Appendix, Ex. 7).

Whether claims 1, 2, 10, 12-15, 18 and 19 are obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008, entered into the record as "**09741521MA**") in view **Lucas**, in view of **Wankow**, "Phthalate Ester Plasticizers-Why and How They Are Used" ("**Phthalate Reference**," Evidence Appendix, Ex. 8), and U.S. Patent 4,856,975 to Gearhart ("**Gearhart**," Evidence Appendix, Ex. 9).

Whether claims 1, 8 and 9 are obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** and further in view of **Urion**.

Whether claims 16 and 17 are obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, **Wankow**, the **Phthalate Reference** and **Gearhart** and further in view of **Chiu**.

VII. ARGUMENT

As is set forth in the arguments below, all of the claims on Appeal should be declared allowable and patentable over 35 U.S.C. § 103(a).

1. Claim 1 Should Be Declared Allowable

In summary form, independent claim 1 is directed to a film cutter with an elongated base, a pair of rails formed at the top surface of the rail base, a channel between the rails, and a blade housing with upper and lower portions. Further, the upper portion houses a blade, a bottom edge that protrudes on either end of the blade, and has an end surface that is rounded and inclined upwardly from the ends of the bottom edge. The blade is angled from the bottom edge. The lower housing portion slides in the channel. The rails are made of a first material that provides attraction and clinging of the film over the rails before, during and after the cutting of the film by the sliding blade/housing in the channel. The first material of the rails contains PVC with at least 10 percent plasticizer, and the rail base is made of a second material containing rigid vinyl or PVC. The first material and the second material are co-extruded and thus form an integrated structure.

A. Rejection of Claim 1 at Page 3, ¶ 5 of the Action

In the Action mailed January 22, 2010 (the “Action”), it is said at page 3, ¶ 5, that claim 1 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

The primary basis for this objection is the combination of **Lucas** and **Wankow**. As an initial matter, there is simply no teaching, suggestion or motivation to combine **Lucas** and

Wankow to arrive at the invention of claim 1, or, in particular, to modify **Lucas** in view of **Wankow**:

Wankow discloses an ordinary box carton containing material wrapped around a roll and having on the lower front edge of the carton a fixed saw blade for cutting the material as it is pulled out of the carton. See Wankow Figures 1 and 2. **Lucas** is a more complex film cutter with a movable blade assembly that includes a roller/blade/housing system that moves along a rail. See Lucas, Col. 3, lines 25-47; Figures 2 and 3. To cut film with **Lucas**, one must roll the blade across the film. To cut film with **Wankow**, one must tear the film across a fixed blade. Thus, the two devices are entirely different, and approach film cutting from two different and opposite directions, and, on their face, do not merit combination.

While **Wankow** does disclose vinyl dots for preventing the material from retracting into the box during use, see Col. 2, lines 46-52, the dots are not used to hold film down on top of a rail cutting surface. Moreover, **Wankow** does not teach, suggest or motivate the ordinary skilled worker to modify **Lucas** to include **Wankow's** vinyl dots on top of a rail used in conjunction with the more complex movable slide cutter disclosed in **Lucas**. Indeed, **Lucas** and **Wankow** are so unlike in structure and function that it is only through hindsight that one could combine them. Thus, neither reference points toward the other. In addition, There is no teaching, suggestion or motivation contained within these references to pick and choose one element of **Wankow** (vinyl spots) out of all the other elements of that box-carton reference to modify **Lucas**.

Moreover, even if, arguendo, **Lucas** and **Wankow** can be properly combined, such combination would still fall short of making out a case of the obviousness of claim 1. As

acknowledged in the Action, at page 7, **Lucas**, does not teach the attractive material of the present invention of polyvinyl chloride comprising at least 10% plasticizer. Rather, it is said that **Lucas** suggests the use of a urethane tape or coating. See Action, pages 6-7. However, the invention defined by the present claims is directed to a unified rail/base of PVC/10% plasticizer rails and rigid PVC base -- not a tape or coating.

It is further important to note that the invention defined by the present claim is directed to a unified rail/rail base of PVC/10% plasticizer rails and rigid PVC base formed by co-extrusion of the rail and rail base materials, as opposed to the placement of a tape or coating on top of a rail. The cited art, either alone or in combination, does not disclose a film cutter comprised of an integrated rail/rail base assembly formed by co-extrusion as set forth in claim 1, and, the Action cites no such art.

Also, neither **Lucas** nor **Wankow** teach or suggest a rail formed of a material for providing attraction to plastic wrap received over the rails for clinging the plastic wrap to the rails “before, during and after cutting” by sliding a blade within a channel formed between the rails. There is no teaching or suggestion in **Wankow** of modifying a rail cutter to integrate a plasticizer which provides cling attraction to the film to be cut. In **Lucas**, a non-slip surface formed of urethane tape is said to be adhered a surface of a single guide. See Col. 3, lines 1-7. Specifically, however, in **Wankow**, there is no teaching or suggestion of modifying **Lucas** to form rails integrated with a rigid rail base by co-extrusion, and with a channel between them that provides cohesion with a film.

Thus, **Lucas** in view of **Wankow** do not teach a rail/rail base uniform structure having one material for providing cling properties for adhering the film to be cut, and another that

provides durability properties, which materials are coextruded to form one integrated rail assembly. Moreover, the present invention has the advantage wherein the rails continuously have the property of co-adhering to film, “before, during and after” the cutting of the film, to the cutter apparatus during use and for the lifetime of the film cutter apparatus. Urethane tape or vinyl spots adhered to a surface of a piece or carton box can lose adherence and can be removed from the box during continuous use over time. Thus, applicants submit that there is no reason that would have prompted one of ordinary skill in the art to combine the vinyl spots adhered to the side of a carton dispenser box of **Wankow** to adherence of the vinyl spots on a rail. And, even if the references were combined, the combination does not teach a uniform cohesive rail/rail base structure formed by coextrusion, not simply adherence of a tape to the rail.

The allegedly supporting references, **Boda**, **Urion**, and **Tsai**, do not support the combination of **Lucas** in view of **Wankow**.

Boda teaches a paper cutter assembly including a unitary base and rail arranged at right angles to each other. The rail assembly is in the form of a right angle extrusion. The angular construction provides a rigid structure throughout its length. See Col. 2, lines 46-61; Figures 1 and 2. However, **Boda** does not teach or suggest co-extrusion to form an adhesive rail material which provides cohesion to a plastic wrap integrated with a base of a rigid material for durability. Further, **Boda** does not teach or suggest co-extrusion of a material of polyvinyl chloride having at least 10% plasticizer and a material of rigid PVC. The selection and combination of the materials in the invention of claim 1 have the advantages of providing a

material for a rail having cling properties and a material for a rail base having durability properties. There is no teaching or suggestion of these advantages in **Boda**.

At page 4 of the July 3, 2007 Action, incorporated in this rejection, it is stated that co-extrusion is well known in the manufacturing of polymers and “does not further limit the structure,” pointing to **Boda** and **Lucas**. Applicants, however, respectfully submit that this is a red herring argument. Neither **Boda** nor **Lucas** disclose a co-extruded film cutter rail structure. All that this portion of the July 3, 2007 Action stands for is that co-extrusion, as a general manufacturing process, can be applied in numerous contexts and does nothing to advance the disclosures or teachings of the relevant rail-based film cutter art with which this claim is specifically concerned.

Urion teaches a cutting assembly by injection molding of side segments and upper wall segments at an angle relative to the position of the completed article. See Col. 3, lines 14-26, Figure 2. However, **Urion** does not teach or suggest co-extrusion to form a rail of a material which provides cohesion to a plastic wrap and a base of a rigid material. Rather, **Urion** is directed to injection molding which is unrelated to the co-extruded structure of the present invention.

Tsai teaches a roller pressed film cutter apparatus. Four rollers are rotatably moving in a track. Film is pulled across the track and upon pushing of the slide holder the rollers will press and tension the film against the track. See Col. 1, lines 30-36, Figures 1-4. In contrast to the invention defined by present claim 1, **Tsai** does not teach or suggest rails being formed of a material providing an attraction to film received over the rails to cling the plastic wrap before, during and after cutting of the plastic wrap.

B. Rejection of Claim 1 at Pages 4-10, ¶ 8 of the Action

Further, in the Action it is said, at pages 4-10, ¶ 8, that claim 1 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008, entered into the record as “09741521MA”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** as set forth in the previous action [Dated June 11, 2009]. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

First, in this rejection, it is submitted, and as is explained below, that the asserted combination of these six references to reject the claim 1 is untenable. Applicants respectfully submit that, on an objective basis, this complex combination of the prior art, including art outside the field of the instant invention, can only be made with the benefit of impermissible hindsight and the picking and choosing of claim elements from disparate art.

The primary reference, **Chuang**, discloses a slidable plastic film cutter with a push button having rollers disposed upon the bottom surface of the push button cutting means. The push button/roller combination is said to inhibit the plastic film from gathering at the bottom of the cutter blade because the film is pressed and pulled tightly during the cutting operation. See **Chuang**, Col. 2, lines 1-14; Figures 3C and 3D.

First, in contrast to the invention defined by the present claims, **Chuang** does not teach or suggest that the rails are formed of a material of polyvinyl chloride comprising at least 10% plasticizer which provides cohesion to the film received over the rails for clinging the film to the rails before, during and after cutting by the sliding blade housing within a channel. Rather, **Chuang** teaches using a roller means for keeping plastic wrap in a tensioned state. During prosecution of the instant application, Applicants showed the Examiner during an interview,

using the artifact ("**09741521MA**") that was modeled after **Chuang**, that **Chuang** does not provide any attraction of the plastic wrap to the rails; the plastic wrap is only held in a tensioned shape by the rollers of the **Chuang** cutter. Thus, there is no teaching or suggestion in **Chuang** of the use of a material to provide cohesion of plastic wrap to rails of a slide cutter device.

Second, there is no objective evidence to make a non-hindsight combination of **Chuang**, **Lucas** and **Wankow**. Indeed, the Action at page 6, acknowledges that "neither **Chuang** nor **Lucas** discloses 'polyvinyl chloride comprising at least 10% plasticizer' ". Moreover, as stated above, **Wankow** is an ordinary box carton with a fixed saw blade. **Chuang** is a much more complex film cutter with a movable roller blade assembly. To cut film with **Chuang**, as with **Lucas**, one must move the blade across the film; to cut film with **Wankow**, one must move the film across the blade. In addition, while the Examiner may believe that there is something functioning on the artifact to attract or adhere film, the objective evidence is that the reference **Chuang**, as opposed to an artifact that may have been made, at any point in time, does not teach, suggest, motivate or disclose the use of an adhesive rail component made of at least 10 percent plasticizer on top of the rails of **Chuang** on the basis of **Lucas** and/or **Wankow**. Moreover, neither **Chuang**, **Lucas** nor **Wankow** disclose a unified rail/rail base formed by the co-extrusion of a rigid PVC material and an adhesive material of at least 10% PVC/plasticizer. In sum, **Chuang**, **Lucas** and **Wankow**, were trying to solve the problem of maintaining some stability of the material to be cut from different directions: **Chuang** (roller assembly), **Lucas** (possibly friction or tape) and **Wankow** (vinyl spot).

Third, this rejection is based upon an expanded combination that adds the **Phthalate Reference** and **Gearhart**. The **Phthalate Reference** does not teach or suggest the use of phthalate ester plasticizers on cutting rails, it merely discusses the use of such plasticizers generally. See Ex. 8, page 1 of 1. Similarly, **Gearhart** generally teaches co-extrusion of PVC to bond a capstock material and is not directed to the film cutting art. See Col. 1, line 54-Col. 2, line 33.

In sum, there is no evidence supporting the combination of references in this rejection and no disclosure of the elements of claim 1 when read as a whole in the prior art. Moreover, there is no evidence that the skilled worker would reach out to the **Phthalate Reference** and **Gearhart**, which are in no way directed to cutting devices, and combine them with **Chuang**, the artifact **09741521MA**, **Lucas** and **Wankow**.

It is respectfully submitted that the combination of this rejection has been incorrectly made with reference to the claimed invention as a guide. Therefore, it is respectfully submitted that this rejection be reversed.

C. Rejection of Claim 1 at Page 11, ¶ 9 of the Action

Further, in the Action, at page 11, ¶ 9, it is said that claim 1 is obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** and further in view of **Urion** as set forth in the previous action [Dated June 11, 2009]. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

In this rejection, the Action combines **Chuang** with **Lucas**, **Wankow**, the **Phthalate Reference**, and **Gearhart** and further in view of **Urion**. This combination is incorrect.

Applicants submit herein, the explanations and arguments set forth above with respect to the combination of **Chuang** with **Lucas**, **Wankow**, the **Phthalate Reference**, and **Gearhart**. In sum, applicants submit that there is no objective evidence to make a non-hindsight combination of **Chuang** (the roller assembly apparatus), **Lucas** (the possibly friction-based or tape attraction device) and **Wankow** (the box-carton device). Further, as detailed above, the **Phthalate Reference** does not teach or suggest the use of phthalate ester plasticizers on cutting rails, it merely discusses the use of such plasticizers generally, and, similarly, **Gearhart** generally teaches co-extrusion of PVC to bond a capstock material and is not directed to the film cutting art.

Further, adding **Urion** to the mix does not advance the argument of unpatentability. As discussed above, **Urion** teaches a cutting assembly by injection molding, not co-extrusion, of side segments and upper wall segments at an angle relative to the position of the completed article. **Urion** does not teach or suggest a co-extruded integrated assembly of a rail of a material which provides cohesion to a plastic wrap, and a base of a rigid material. Accordingly, the invention defined by claim 1 is not obvious over **Chuang** in view of **Lucas**, **Wankow**, the **Phthalate Reference**, and **Gearhart** and further combined with **Urion**.

Finally, with respect to the rejections stated above with respect to independent claim 1 (and the claims dependent therefrom, as discussed below), it should be noted that the claimed invention provides for, inter alia, “clinging said plastic wrap to said rails before, during and after cutting of said plastic wrap” by the sliding of the blade housing between the rails. This feature of the invention results from the fact that the rails are formed of poly vinyl chloride “with at least 10 percent plasticizer,” which, in turn, results in providing a “cohesive” attraction between

the rails and the film, as opposed to a “friction” or “adhesive” attraction provided by the prior art. See Supp. Vegliante Decl., pages 1-2, ¶¶ 2-3.

For the above reasons, claim 1 should be declared allowable.

2. Claim 2 Should Be Declared Allowable

Claim 2 depends from claim 1 and further recites the additional element wherein the upper portion of the blade housing of the film cutter has a grip surface having a concave shape.

A. Rejection of Claim 2 at Page 3, ¶ 6 of the Action

In the Action, it is said, at page 3, ¶ 6, that claim 2 is obvious under 35 U.S.C. § 103(a) over **Lucas** in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, **Tsai**, and further in view of **Chuang** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

Applicants submit herein, the explanations set forth above with respect to the combination of **Lucas**, **Wankow** and **Chuang** as applied to claim 1 in points 1B and 1C above. In sum, applicants submit that there is no objective evidence to make a non-hindsight combination of **Lucas**, **Wankow** and **Chuang**. In addition, while **Chuang** has a push button with a partially concave surface, it cannot be combined with the improper combination of **Lucas** and **Wankow** for reasons that are virtually the same as those militating against the **Lucas/Wankow** combination alone, even with impermissible hindsight picking and choosing. That is, simply stated, **Wankow** is an ordinary box carton with a fixed saw blade. **Chuang** is a much more complex film cutter with a movable roller blade assembly. To cut film with **Chuang**, one must move the blade across the film; to cut film with **Wankow**, one must move the film across the blade. In addition, **Chuang**, **Lucas** and **Wankow** do not disclose a co-extruded rigid rail

base/adhesive rail structure. Clearly, **Chuang** and **Wankow**, as with **Lucas** and **Wankow**, were trying to solve problems from two different directions, and do not contain sufficient teachings to render claim 2 obvious.

Further, as set forth above with respect to independent claim 1, **Boda**, **Urion** and **Tsai** do not provide sufficient supporting evidence. In sum, as stated above, **Boda** does not teach or suggest co-extrusion to form a rail material which provides cohesion to a film and an integrated base of a rigid material. Further, **Boda** does not teach or suggest co-extrusion of a material of polyvinyl chloride having at least 10% plasticizer and a material of rigid vinyl or PVC. **Urion** does not teach or suggest co-extrusion to form a rail of a material which provides an attraction to a plastic wrap and a base of a rigid material. Finally, **Tsai** does not teach or suggest rails being formed of a material providing cohesion to film received over the rails to cling the film before, during and after its cutting.

B. Rejection of Claim 2 at Pages 4 - 10, ¶ 8 of the Action

Further, in the Action it is said, at page 4, ¶ 8, that claim 2 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by [an undisclosed] third party on 8/25/2008, entered into the record as "09741521MA") in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** as set forth in the previous action [Dated June 11, 2009]. The applicants submit that this rejection is also erroneous and should be reversed for the following reasons.

First, as stated above with respect to claim 1 and this same rejection, it is submitted, as is explained below, that the asserted combination of these six references to reject claim 2 is untenable. On an objective basis, this complex combination of the prior art, including art

outside the field of the instant invention, can only be made with the benefit of impermissible hindsight and the picking and choosing of claim elements from disparate art.

Second, as stated more fully above, the primary reference, **Chuang**, discloses a slidable plastic film cutter with a push button having rollers disposed upon the bottom surface of the push button cutting means. The push button/roller combination is said to inhibit the plastic film from gathering at the bottom of the cutter blade because the film is pressed and pulled tightly during the cutting operation. See Col. 2, lines 1-14; Figures 3C and 3D. While **Chuang** discloses a button, it does not teach or suggest that the rails are formed of a material of polyvinyl comprising at least 10% plasticizer for cohesion to film received over the rails and for clinging the film to the rails “before, during and after” cutting of the film.

Third, as set forth above, there is no objective evidence to make a non-hindsight combination of **Chuang**, **Lucas** and **Wankow**, because **Chuang**, **Lucas** and **Wankow**, were trying to solve the problem of maintaining some stability of the material to be cut starting from different directions. Further, none of the cited references disclose the rail base/rail co-extruded structure described above.

Fourth, as stated more fully above, this rejection is based upon an expanded combination that adds the **Phthalate Reference** and **Gearhart**. The **Phthalate Reference** does not teach or suggest the use of phthalate ester plasticizers on cutting rails, it merely discusses the use of such plasticizers generally. Similarly, **Gearhart** generally teaches co-extrusion of PVC to bond a capstock material and is not directed to the film cutting art.

In this vein, it again stressed that the Action merely asserts that each of the elements of claim 2 was, independently, known in the prior art. It provides no reason that would have

prompted a person of ordinary skill in the relevant field to combine the elements in the way claim 2 does. There must be “actual evidence” supporting the combination. Here there is none. Also, applicants further submit that these additional elements render the invention patentable over the cited prior art.

For the above reasons, claim 2 should be declared allowable.

3. Claim 8 Should Be Declared Allowable

Claim 8 depends from claim 1 with the further element that that the blade housing is formed of a flexible material providing lubricity.

A. Rejection of Claim 8 at Page 3, ¶ 5 of the Action

In the Action, it is said at page 3, ¶ 5, that claim 8 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claim 1. In addition, there is no teaching in any of these references of a blade housing that is made of a flexible material that provides lubricity for the sliding of the housing and blade over the rails of claim 8. Moreover, it does not appear that the Examiner addressed this point in the Action or the prior action of July 3, 2007. It is further submitted that this further element of claim 8 renders the invention patentable over the cited prior art.

B. Rejection of Claim 8 at Page 11, ¶ 9 of the Action

The Action also states, at page 11, ¶ 9, it is said that claim 8 is obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** and further in view of **Urion** as set forth in the previous action [Dated June 11, 2009]. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claim 1. In addition, there is no teaching in any of these references of a blade housing that is made of a flexible material that provides lubricity for the sliding of the housing and blade over the rails of claim 8. Moreover, it does not appear that the Examiner addressed this point in the Action or the prior action of July 3, 2007. Also, it is further submitted that this further element of claim 8 renders the invention patentable over the cited prior art.

For the above reasons, claim 8 should be declared allowable.

4. Claim 9 Should Be Declared Allowable

Claim 9 depends from claim 8 with the further element that that the blade housing is formed from acetal or silicon.

A. Rejection of Claim 9 at Page 3, ¶ 5 of the Action

In the Action, it is said at page 3, ¶ 5, that claim 9 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claims 1 and 8. In addition, applicants submit that these further elements render the invention patentable over the cited prior art.

B. Rejection of Claim 9 at Page 11, ¶ 9 of the Action

Further, in the Action, at page 11, ¶ 9, it is said that claim 9 is obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** and further in view of **Urion** as set forth in the previous action [Dated June 11, 2009].

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claims 1 and 8. In the Action, at page 11, ¶ 9, it is admitted that **Chuang** in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** “does not disclose the use of acetal as the material of for the blade housing.” However, the Action states that **Urion** discloses “using acetal as the material for a sliding rail style cutting blade holder/housing” *Id.* While this may be correct, **Urion** still suffers from the same deficiencies as set forth above with respect to applicants’ arguments regarding this same rejection as to claim 1, namely, **Urion** teaches a cutting assembly made by injection molding of side segments and upper wall segments, etc. **Urion** does not teach or suggest a co-extruded rail of a material which provides an attraction to a plastic wrap and a base of a rigid material. Further, no actual evidence was given for making the combination of these references. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

For the above reasons, claim 9 should be declared allowable.

5. **Claim 10 Should Be Declared Allowable**

Claim 10 depends from claim 1 with the additional element “wherein said blade housing is formed of a left section and a right section, said blade is attached to said left section and said right section with a rivet extending through an aperture of said blade.”

A. Rejection of Claim 10 at Page 3, ¶ 5 of the Action

In the Action, it is said at page 3, ¶ 5, that claim 10 is obvious under 35 U.S.C. § 103(a) over Lucas, in view of Wankow, with supporting evidence from Boda, Urion, and Tsai as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, there is no teaching or suggestion in the cited references to add the feature of a blade housing wherein the blade is attached to left and right sections with a rivet to the already erroneous combination of elements from multiple references made with respect to claim 1. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

B. Rejection of Claim 10 at Pages 4-10, ¶ 8 of the Action

Further, in the Action it is said, at pages 4-10, ¶ 8, that claim 10 is obvious under 35 U.S.C. § 103(a) over Chuang (and an artifact submitted by a third party on 8/25/2008, entered into the record as “09741521MA”) in view of Lucas, in view of Wankow, the Phthalate Reference, and Gearhart as set forth in the previous action [Dated June 11, 2009]. The

applicants submit that this rejection is also erroneous and should be reversed for the following reasons.

First, for the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1.

Second, the Action, at page 9, acknowledges that “**Chuang** does not disclose a rivet connecting the blade to the left and right sides of the housing.” However, the Action asserts at page 9, that **Chuang** uses an adhesive. Further, the Examiner states that he “takes official notice that adhesive is a functional equivalent of a rivet and that they can be substituted at will.” Id. The Action, at the same page goes on to say that it “would have been obvious to use a rivet instead of an adhesive, since either would work as well as the other and the two are art recognized equivalents.” Id. The applicants submit that the forgoing assertions are without sufficient basis. The Action does not provide any support whatsoever for the assertion that the use of a rivet was, at the time of the invention, known to be interchangeable with an adhesive in the context of the present invention (film cutter blade housings wherein plastic wall housings are riveted to a blade to secure it in the core), or any other invention for that matter. In addition, even if all adhesives and all rivets were equivalent and interchangeable for all purposes at the time of the invention, which proposition the Action provides no evidence for, there is no teaching or suggestion in the art cited to add an additional blade/walls riveting feature to the improper combination of elements from multiple references already made with respect to claim 1. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

For the above reasons, claim 10 should be declared allowable.

6. Claim 12 Should Be Declared Allowable

Claim 12 depends from claim 1 and adds the further element “wherein said blade is angled at a 30° angle from said bottom edge of said upper portion.” The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

A. Rejection of Claim 12 at Page 3, ¶ 5 of the Action

In the Action, it is said at page 3, ¶ 5, that claim 12 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, even if **Lucas** discloses a 30° angled blade, there is no teaching or suggestion in the art cited that would direct the skilled worker to add a 30° angled blade of the bottom edge of an upper housing portion to the erroneous combination of elements from multiple references already made with respect to claim 1. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

B. Rejection of Claim 12 at Pages 4-10, ¶ 8 of the Action

Further, in the Action it is said, at pages 4-10, ¶ 8, that claim 12 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008, entered into the record as “09741521MA”) in view **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** as set forth in the previous action [Dated June 11, 2009].

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, even if

Chuang discloses a 30° angled blade, there is no teaching or suggestion in the art cited that would direct the skilled worker to add a 30° angled blade of the bottom edge of an upper housing portion to the already erroneous combination of elements from multiple references made with respect to claim 1. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

For the above reasons, claim 12 should be declared allowable.

7. Claim 13 Should Be Declared Allowable

Claim 13 depends from claim 1 with the further element “wherein said lower portion is formed of a tracking device for slidably moving in said channel.”

A. Rejection of Claim 13 at Page 3, ¶ 5 of the Action

In the Action, it is said at page 3, ¶ 5, that claim 13 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1 and 12. In addition, it is submitted that there is no teaching or suggestion in any of the cited references for a further addition to an already erroneous combination of elements from multiple references made with respect to claim 1 that includes a lower portion of a blade housing that is formed of a tracking device for slidably moving in a rail base channel. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

B. Rejection of Claim 13 at Pages 4-10, ¶ 8 of the Action

Further, in the Action it is said, at pages 4-10, ¶ 8, it is said that claim 13 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008, entered into the record as “09741521MA”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** as set forth in the previous action [Dated June 11, 2009].

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, it is submitted that there is no teaching or suggestion in any of the cited references for a further addition to an already erroneous combination of elements from multiple references made with respect to claim 1 that includes a lower portion of a blade housing that is formed of a tracking device for slidably moving in a rail base channel. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

For the above reasons, claim 13 should be declared allowable.

9. Claim 14 Should Be Declared Allowable

Claim 14 depends from Claim 13 (which depends from claim 1) with the additional element “wherein said tracking device is formed of a tubular base, a middle portion attaches said lower portion to said upper portion and said tubular base sliding in said channel having a corresponding tubular base.”

A. Rejection of Claim 14 at Page 3, ¶ 5 of the Action

In the Action, it is said at page 3, ¶ 5, that claim 14 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set

forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1, 12 and 13. In addition, it is submitted that there is no teaching or suggestion in any of the cited references, alone or in combination, of a tubular tracking device base, a middle portion attaching the lower portion to the upper portion of the housing, and said tubular base sliding in the channel having a corresponding tubular base. Moreover, the Action is merely adding these additional features that do not exist in the cited art to an already erroneous combination of elements from multiple references made with respect to the rejection of claims 1 and 13 based on this art. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

B. Rejection of Claim 14 at Pages 4-10, ¶ 8 of the Action

Further, in the Action it is said, at pages 4-10, ¶ 8, it is said that claim 14 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008, entered into the record as “09741521MA”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** as set forth in the previous action [Dated June 11, 2009].

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1 and 13. In addition, the Action, at page 10, acknowledges that **Chuang** discloses a T-shaped tracking device rather than a “tubular” device, and asserts therein that the main feature of the tracking device and channel is that they are of corresponding shapes. The applicant submits, however, that this difference

is significant in light of the fact that the Action is simply adding what is clearly two distinctive features to the already erroneous combination of elements from multiple references made with respect to the rejection of claims 1 and 13 based on this art. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

For the above reasons claim 14 should be declared allowable.

10. Claim 15 Should Be Declared Allowable

Claim 15 depends from claim 14 with the additional element “wherein said middle portion has predetermined length to provide a predetermined clearance between said blade and said rails.”

A. Rejection of Claim 15 at Page 3, ¶ 5 of the Action

In the Action, it is said at page 3, ¶ 5, that claim 15 is obvious under 35 U.S.C. § 103(a) over Lucas, in view of Wankow, with supporting evidence from Boda, Urion, and Tsai as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1, 13 and 14. In addition, the Action is merely adding the additional clearance feature to the already erroneous combination of elements from multiple references made with respect to the rejection of claims 1, 13 and 14 based on this art. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

B. Rejection of Claim 15 at Pages 4-10, ¶ 8 of the Action

Further, in the Action it is said, at pages 4-10, ¶ 8, that claim 15 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008, entered into the record as “09741521MA”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** as set forth in the previous action [Dated June 11, 2009]. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1, 13 and 14. In addition, the Action has misperceived the “predetermined clearance” feature of this claim 15 with respect to its discussion of the claim and **Chuang** at page 10 of the Action. In particular, the Action there states that “**Chuang** does disclose that the middle portion is of predetermined length, since it is designed to fit within the channel as that is designed (see figure 3C of **Chuang**)(emphasis added.)” Claim 15 recites, however, that the middle portion “has predetermined length to provide a predetermined clearance between said blade and said rail (emphasis added.)” Hence, the Action overlooks the fact that claim 15, unlike **Chuang**, features a blade/rail assembly that has a clearance between the blade and rail, not a snug fit. Moreover, the Action is merely adding the added clearance feature to the already erroneous combination of elements from multiple references made with respect to the rejection of claims 1, 13 and 14 based on this art. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

For the above reasons claim 15 should be declared allowable.

11. Claims 16 and 17 Should Be Declared Allowable

Claim 16 depends from claim 13 (which depends from claim 1) wherein the claim 13 apparatus comprises “a pair of end caps releasably attached to either end of said elongated rail base for providing a bumper of said tracking device in said channel with said end caps, said end caps releasing upon application of excessive force.”

Claim 17 depends from claim 16 and adds the element wherein the “end cap includes a pair of male protrusions which engage a pair of respective female receptacles on a slide surface of said elongated rail base.”

A. Rejection of Claims 16 and 17 at Page 4, ¶ 7 of the Action

In the Action, at page 4, ¶ 7, it is said that claims 16 and 17 are obvious under 35 U.S.C. § 103(a) over **Lucas** in view of **Wankow** with supporting evidence from **Boda, Urion, Tsai** and further in view of **Chiu** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

As set forth above, there is no basis to combine **Lucas** and **Wankow**, with or without the aid of **Boda, Urion** and **Tsai** to render unpatentable claim 1 and those claims which depend from claim 1, directly or indirectly. In addition, there is no basis to further increase the combination of five references by adding a sixth, **Chiu**, to arrive at claims 16 and 17.

Chui discloses a fairly simple sliding cutting device for a roll of protective film, and is deficient in disclosing the instant invention in combination with **Lucas** and **Wankow**, with or without the aid of **Boda, Urion** and **Tsai**. See Figure 1. What is more, with respect to the additional limitations of claims 16 and 17, taking into account all of the words of claims, it is

seen that **Chiu** does not disclose “a pair of end caps” (claim 16) and “a pair of male protrusions which engage a pair of female receptacles on a side surface of said elongated base.” (Claim 17.) **Chui** discloses, at best, one movable upright rear stop plate (33) with a protrusion that apparently fits into the end of the elongated member. See **Chiu** Fig. 3. By contrast, the front end of the **Chiu** positioning unit (31), which is opposite to the single movable stop plate (33), is said to be “mounted securely on the front end portions of the slide”, and is not disclosed as moveable. Further, just toward the front end of the positioning unit (which is opposite to the single movable stop plate), **Chui** further discloses the use of immovable internal stop blocks in the form of small tabs (315) to block the horizontal plates (327) of the guide unit, a feature not present in the instant claims 16 and 17. See **Chui**, Col. 2, line 66 to Col. 3, line 5; Col. 3, lines 48-57; Figure 3. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

Thus, in light of the claims, read as a whole, and the prior art teachings, read without picking and choosing, it is submitted that claims 16 and 17 are not obvious under Section 103(a), and should therefore be declared allowable.

B. Rejection of Claims 16 and 17 at Pages 11 - 12, ¶ 10 of the Action

In the Action, at page 11, ¶ 10, it is said that claims 16 and 17 are obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, **Wankow**, the **Phthalate Reference** and **Gearhart** and further in view of **Chiu**.

For brevity’s sake, Applicants repeat their arguments and objections made above with respect to the combinations and disclosures of **Chuang**, **Lucas** and **Wankow** and the **Phthalate Reference** and **Gearhart** as applied to claim 1. In addition to the arguments previously made

with respect to the aforementioned combination, Applicants further respectfully submit that these references, view of **Chui**, a six way combination is not a proper combination, and the rejection of claims 16 and 17 on this combination is erroneous.

Further, taking into account all of the words of the claims, it is seen that **Chiu** does not disclose “a pair of end caps” (claim 16) and “a pair of male protrusions which engage a pair of female receptacles on a side surface of said elongated base (Claim 17.)” **Chui** discloses, at best, one movable upright rear stop plate (33) with a protrusion that apparently fits into the end of the elongated member. See Fig. 3. By contrast, the front end of the positioning unit (31) which is opposite to the single movable stop plate (33) is said to be “mounted securely on the front end portions of the slide”, and is not disclosed as moveable. Further, just the toward the front end of the positioning unit opposite to the single movable stop plate, **Chui** further discloses the use of immovable internal stop blocks in the form of small tabs (315) to block the horizontal plates (327) of the guide unit. See **Chui**, Figure 3; Col. 2, line 66 to Col. 3, line 5; Col. 3, lines 48-57.

Thus, in light of the claims, read as a whole, and the prior art teachings, read without picking and choosing and hindsight, it is respectfully submitted that claims 16 and 17 are not obvious under Section 103(a). Also, applicants submit that these further elements render the invention patentable over the cited prior art.

Therefore, claims 16 and 17 should be declared allowable.

13. Claim 18 Should Be Declared Allowable

Claim 18 depends from claim 1 and adds the element “wherein a rear edge of said elongated rail base includes a depression . . . being adapted to receive a cover of a carton of said film.”

A. Rejection of Claim 18 at Page 3, ¶ 5 of the Action

In the Action, it is said at page 3, ¶ 5, that claim 18 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, Moreover, the Action is merely adding the depression feature to the already erroneous combination of elements from multiple references made with respect to the rejection of claim 1. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

B. Rejection of Claim 18 at Pages 4-10, ¶ 8 of the Action

Further, in the Action it is said, at pages 4-10, ¶ 8, it is said that claim 18 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008, entered into the record as “09741521MA”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** as set forth in the previous action [Dated June 11, 2009]. The applicants submit that this rejection is also erroneous for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, the secondary references, including **Lucas**, do not teach or suggest the modification of **Chuang** to include a depression adapted to receive a cover of a carton of said film as set forth in claim 18. Also, applicants submit that these further elements render the invention patentable over the cited prior art.

For the above reasons, claim 18 should be declared allowable.

14. Claim 19 Should Be Declared Allowable

In summary form, independent claim 19 is directed to a method of cutting plastic wrap. The method utilizes an elongated rail base, at least one rail formed at the top surface of the rail base, receiving the plastic wrap over a pair of rails formed at the top surface of the rail base, and the rails are formed of a material which provides an attraction to and clinging of the wrap to the rails. The rail material is selected from the group consisting of vinyl and polyvinyl chloride, and wherein the PVC comprises at least 10% plasticizer, and the elongated base rail is formed of a second material of rigid vinyl or rigid PVC. The first and second materials are coextruded and thus form a unified structure. The method further includes cutting the wrap with a blade in a housing, and wherein the blade is angled from a bottom edge of said upper portion, and the blade housing slides or moves in a channel formed within the rail base and between the rails. Further, according to this method, the plastic wrap clings to said rails before, during and after cutting of said plastic wrap.

A. Rejection of Claim 19 at Page 3, ¶ 5 of the Action

In the Action, it is said, at page 3, ¶ 5, thereof, that claim 19 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, applicants submit that none of the cited references disclose, alone or in combination, the use of PVC comprising 10% plasticizer over the rails to ensure that the plastic wrap clings to said rails before, during and after cutting of said plastic wrap.

B. Rejection of Claim 19 at Pages 4-10, ¶ 8 of the Action

Further, in the Action it is said, at pages 4-10, ¶ 8, it is said that claim 19 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008, entered into the record as “09741521MA”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** as set forth in the previous action [Dated June 11, 2009]. The applicants submit that this rejection is also erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, applicants submit that none of the cited references disclose, alone or in combination, the use of PVC comprising 10% plasticizer over the rails to ensure that the plastic wrap clings to said rails before, during and after cutting of said plastic wrap. Moreover, the cited art does not disclose

a rail base/rail integrated structure formed by co-extrusion of two materials, one rigid and the other containing an adhesive, as described above.

For the above reasons, claim 19 should be declared allowable.

***The Objective Evidence Of The Commercial Success And Copying
Of The Claimed Invention Demonstrates That The Claims Are Allowable***

The Action, at pages 15-20, has rejected all of the claims on appeal despite applicants' strong showing of commercial success and copying of the claimed invention as is demonstrated in the **Vegliante Decl.** and the **Supp. Vegliante Decl.**

In summary, the Action states that there is an insufficient showing in applicants' evidence of a nexus between the commercial success of the claimed invention and the features of the invention. See Action, pages 15-16 and 19. In particular, the Action states that “[p]erhaps all of the sales were based on price, shipping times, customer service” or some other factor except the features of the invention. Action at page 16 (emphasis added.)

Applicants respectfully submit that the Action set too high a bar for demonstrating commercial success, and discounted the strong sales and market penetration of the claimed invention by engaging, in part, on conjecture, despite the fact, as stated in the Declarations, that the success of the claimed invention was achieved without any advertising or promotion. **Vegliante Decl.**, pages 16-17, ¶¶ 19-21.

Commercial Success

As shown in the **Vegliante Decl.**, which amply demonstrates great commercial success, *without any advertising of the claimed invention*, “an important feature highly appreciated by the customers and users is the functioning of the slide cutter product based on the cling of the plastic wrap to the cutter to enable the plastic wrap to be held in place before, after and during

the cutting of the plastic wrap.” See **Vegliante Decl.** page 6-17, ¶¶ 19-21 (emphasis added.). Thus, the commercial success of the product is tied to the heart of the invention as claimed.

In the **Supp. Vegliante Decl.**, applicants submitted more detailed evidence that cannot be disputed as being totally objective on the issue of commercial success. In particular, applicants demonstrated, through the **Supp. Vegliante Decl.**, at pages 3-4 thereof, and the Plastic Wrap Market Report (“PWMR”), an entirely independent study of the relevant plastic wrap and cutter market (Exhibit G to the **Supp. Vegliante Decl.**), that there is no credible dispute that (1) AEP’s, [applicants’ assignee], slide film cutter was a huge commercial success, and (2) the commercial AEP slide cutter is what is covered by at least independent claim 1 of the instant application. In addition, the PWMR demonstrates that by 2005, AEP’s slide cutter penetrated 25 percent of a market dominated by huge and long-established competitors. Moreover, and importantly, AEP’s high sales (on the order of 30-70 million) of its cutter have been made without any advertising and promotion. Those sales were due to the slide cutter claimed in the instant application. Thus, on the basis of this evidence alone, and as a matter of both law and fact, applicants’ have made a *prima facie* case of commercial success and a nexus between that success and the claimed invention. **Supp. Vegliante Decl.**, pages 3-4, ¶¶ 4-10.

In addition, patent applications for the slide cutter of the instant invention have been granted in Canada, Australia and New Zealand, the only foreign countries where such applications were filed. *Id.* at page 4, ¶ 11.

Copying

In addition to the high commercial success of the claimed invention as set forth in the **Vegliante Decl.** and the **Supp. Vegliante Decl.**, the applicants have also demonstrated with the

support of those declarations and the exhibits thereto that the claimed invention has been the subject of wide-spread copying. In summary, the slide cutter of the instant application was and is the subject of worldwide copying which is a fact that, standing almost alone, can be determinative of non-obviousness. Advanced Display Systems, Inc. v. Kent State University, 212 F.3d 1272, 1285, 54 U.S.P.Q. 2d 1673, 1682 (Fed. Cir. 2000)(wholesale copying provides compelling evidence of nonobviousness). The Vegliante Declarations and the Exhibits thereto point to a litany of copiers of the instant invention; just to name a few:

- Reynolds Company
- Anchor Wrap Packaging
- Diamant Films Inc.
- Pliant Corporation
- Polyvinyl Company
- Metal Edge International, Inc.
- Durable Packaging International

Supp. Vegliante Decl., pages 4 - 5, ¶¶ 16-19.


It is therefore respectfully submitted that the great weight of the objective evidence on commercial success and copying further demonstrates that the claims of the instant application are patentable under 35 U.S.C. § 103(a).

CONCLUSION

For the reasons set forth above, applicants submit that the rejections of the claims subject to this appeal are erroneous and should be reversed and that all claims subject to this Appeal be declared allowable.

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Respectfully submitted,



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VIII. CLAIMS APPENDIX

1. (Previously presented) A film cutter apparatus for cutting plastic wrap comprising:

an elongated rail base;

a pair of rails formed at a top surface of said elongated rail base and a channel formed within said rail base and between said rails; and

a blade housing formed of an upper portion and a lower portion;

said upper portion of said blade housing houses a blade, a bottom edge of said upper portion of said blade housing protruding on either end from said blade and an end surface being rounded and inclined upwardly and from either end of said bottom edge, said blade is angled from said bottom edge of said upper portion;

said lower portion of said blade housing slidably moving in said channel,

wherein said rails are formed of a first material which provides an attraction to said plastic wrap received over said rails for attracting said plastic wrap received over said rails for clinging said plastic wrap to said rails before, during and after cutting of said plastic wrap by sliding said blade housing within said channel wherein said first material is polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer wherein said elongated base rail is formed of a second material of rigid vinyl or rigid PVC and said first material is coextruded with said second material.

2. (Original) The film cutter of claim 1 wherein said upper portion of said blade housing has a grip surface, said grip surface having a concave shape.

3. (Canceled).

4. (Canceled).

5. (Canceled).

6. (Canceled).

7. (Canceled).

8. (Original) The apparatus of claim 1 wherein said blade housing is formed of a flexible material providing lubricity.

9. (Original) The apparatus of claim 8 wherein said blade housing is formed of acetal or silicon.

10. (Original) The film cutter of claim 1 wherein said blade housing is formed of a left section and a right section, said blade is attached to said left section and said right section with a rivet extending through an aperture of said blade.

11. (Canceled).

12. (Previously presented) The apparatus of claim 1 wherein said blade is angled at a 30° angle from said bottom edge of said upper portion.

13. (Original) The apparatus of claim 1 wherein said lower portion is formed of a tracking device for slidably moving in said channel.

14. (Previously presented) The apparatus of claim 13 wherein said tracking device is formed of a tubular base, a middle portion attaches said lower portion to said upper portion and said tubular base sliding in said channel having a corresponding tubular shape.

15. (Original) The apparatus of claim 14 wherein said middle portion has predetermined length to provide a predetermined clearance between said blade and said rails.

16. (Previously presented) The apparatus of claim 13 further comprising a pair of end caps releasably attached to either end of said elongated rail base for providing a bumper of said tracking device in said channel with said end caps, said end caps releasing upon application of excessive force.

17. (Original) The apparatus of claim 16 wherein said end cap includes a pair of male protrusions which engage a pair of respective female receptacles on a side surface of said elongated rail base.

18. (Original) The apparatus of claim 1 wherein a rear edge of said elongated rail base includes a depression, said depression being adapted to receive a cover of a carton of said film.

19. (Previously presented) A method for cutting a plastic wrap comprising an elongated rail base;
at least one rail formed at a top surface of said elongated rail base;

receiving said plastic wrap over a pair of rails formed at a top surface of an elongated rail base:

clinging said plastic wrap to said rails, said rails are formed of a material which provides an attraction to said received plastic wrap for clinging of said plastic wrap to said rails wherein said material is selected from the group consisting of vinyl and polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, said elongated base rail is formed of a second material of rigid vinyl or rigid PVC and said first material is coextruded with said second material; and cutting said plastic wrap with a blade, said blade being housed in a blade housing, said blade is angled from said bottom edge of said upper portion, said blade housing being slidably moveable in a channel formed within said rail base between said rails,

wherein said plastic wrap clings to said rails before, during and after cutting of said plastic wrap.

20. (Canceled).

21. (Canceled).

IX. EVIDENCE APPENDIX

The following exhibits are relied upon by applicants in connection with this appeal:

Exhibit Nos:

1. U.S. Patent 5,440,961 to Lucas, Jr. et al. (hereinafter, "**Lucas**"). **Lucas** was entered into the record in the Official Office Action mailed and entered in PAIR on February 1, 2005.
2. U.S. Patent 3,549,066 to Wankow (hereinafter, "**Wankow**"). **Wankow** was entered into the record in the Official Office Action mailed and entered in PAIR on November 30, 2006.
3. U.S. Patent 5,524,515 to Boda (hereinafter, "**Boda**"). **Boda** was entered into the record in the Official Office Action mailed and entered in PAIR on March 8, 2006.
4. U.S. Patent 4,210,043 to Urion et al. (hereinafter, "**Urion**"). **Urion** was entered into the record in the Official Office Action mailed and entered in PAIR on March 8, 2006.
5. U.S. Patent 5,036,740 to Tsai (hereinafter, "**Tsai**"). **Tsai** was entered into the record in the Official office Action mailed and entered in PAIR on April 23, 2002.
6. U.S. Patent 4,960,022 to Chaung (hereinafter, "**Chuang**"). **Chuang** was entered into the record in the List of References cited by applicant and considered by examiner entered in PAIR on January 2, 2003.
7. U.S. Patent 5,398,576 to Chiu (hereinafter, "**Chiu**"). **Chiu** was entered into the record in the Official Office Action mailed and entered in PAIR on January 2, 2003.
8. Page 8 of an article cited in the Notice of References Cited attached to Official Office Action mailed October 1, 2008, entitled "Phthalate Ester Plasticizers – Why and How

They Are Used.” P.R. Graham, Environmental Health Perspectives, Vol. 3, (Jan., 1973), pp. 8, Published by: The National Institute of Environmental Health Sciences (NIEHS) (“**Phthalate Reference**”). The **Phthalate Reference** was entered into the record in the Notice of References Cited and the Official office Action mailed and entered in PAIR on October 1, 2008.

9. U.S. Patent 4,856,975 to Gearhart (hereinafter, “**Gearhart**”). **Gearhart** was entered into the record in the Notice of References Cited and the Official Office Action mailed and entered in PAIR on October 1, 2008.
10. Declaration of Paul Vegliante submitted under 37 CFR 1.132, dated July 18, 2008 with exhibits A-F thereto. (“**Vegliante Decl.**”). The **Vegliante Decl.** was entered into the record in PAIR on July 18, 2008.
11. Supplemental Declaration of Paul Vegliante Submitted Under 37 CFR 1.132, dated December 9, 2009, with exhibits G-N thereto. (“**Supp. Vegliante Decl.**”). The **Supp. Vegliante Decl.** was entered into the record in PAIR on December 11, 2009.

X. RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by a Court or the Board in any related proceeding or any proceeding identified pursuant to 37 C.F.R. § 41.37(c)(1)(ii).